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DPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Dong-II CHA et al

Application No.: 10/777,673

Group Art Unit: 2811

Confirmation No.: 5888

Filed: February 13, 2004

Examiner: Crane, Sara W.

For: MOBILE ELECTRONIC APPARATUS CAPABLE OF FUNCTIONING AS IMAGE REPRODUCTION MEDIUM AND REPRODUCTION METHOD THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Response to the Election/Restriction Requirement Office Action mailed August 24, 2005, having a shortened period for response set to expire on September 26, 2005 (September 25, 2005 falling on a Sunday). The following election of invention and remarks are provided.

The Examiner states that the application includes claims directed to more than one invention, and divides the claimed inventions into two groups:

Group I, including claims 1-11 and 16-18, are drawn to a mobile electronic apparatus, classified in class 315, subclass 169.3.

Group II, including claims 12-15, are drawn to a method of reproducing an image storage medium, classified in class 348, subclass 135.

The Examiner states that these two groups are directed to two distinct inventions, because they are related as product and process of use.

I. Election of Claims Pursuant to 37 CFR §1.143

In response to restriction requirement, Applicants elect Group I claims 1-11 and 16-18.

II. Applicants Traverse the Restriction Requirement Pursuant to 37 CFR 1.143

MPEP §803 provides there are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and

(B) There must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a) and §808.02).

Applicants traverse the restriction requirement as follows:

(A) Inventions must be independent or distinct criteria:

The Examiner has applied MPEP 806.05(h) - Product and Process of Using. MPEP 806.05(h) provides:

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

The Office Action in page 2 alleges, "In the instant case, the method of reproducing an image storage medium can be practiced with a device which does not include the limitation of for example claim 1, lines 11-12, where the mobile apparatus operates independently from the stand. Also, the method could be practiced with some medium other than a DVD, as recited in for example claims 17-18."

At least *prima facie*, the restriction requirement is not proper and the restriction requirement is hereby traversed, because in order to perform the process disclosed in the Group II method claims, the mobile apparatus stand should be detachably connected to the mobile electronic apparatus ("activating an operation of the mobile electronic apparatus **when the mobile electronic apparatus is connected to the mobile apparatus stand**" - Group II, claim

12) and the mobile apparatus stand should include the hardware for reproducing from an A/V storage medium, and an interface should be provided between the mobile apparatus stand and the mobile electronic apparatus. For example, Group I, claim 1, recites, "**wherein, while the mobile apparatus stand is connected to the mobile apparatus body**, the mobile apparatus stand outputs both the A/V signal and the body control signal to the mobile apparatus body based on the input stand control signal output from the mobile apparatus body, wherein the A/V signal is reproduced from an A/V storage medium, and the body control signal controls an operation of the mobile apparatus body." In other words, the method of the Group II can be implemented only by the electronic apparatus of the Group I claims. Therefore, the Group I and the Group II are not directed to two distinct inventions, and the restriction requirement is unreasonable.

(B) Serious burden on Examiner criteria:

The Office Action has not set forth a serious burden on the Examiner to require restriction. Further, in view of the remarks herein, it is submitted that the search and examination can be made without a serious burden - see, MPEP 803.

The Applicants request reconsideration and withdrawal of the restriction requirement. In view of the remarks and when all of the other various facts discussed herein are taken into consideration, the criteria for a restriction requirement has not been met and all of the pending claims 1-18 should be examined together in the subject application and withdrawal of the restriction requirement is respectfully requested.

If any further fees are required in connection with the filing of this response, please charge the same to our deposit account number 19-3935.

Respectfully submitted,
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